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In re Application of
Pawlak, et al.
Application No. 09/306,474
Filed: May 6, 1999
Attorney Docket No. METRIKA-013
For: Blocking Compositions for
Immunoassays

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed July 26, 2000 (certificate of mailing July 21, 2000), to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

This application became abandoned for failure to respond in a timely manner to the Notice to File Missing Parts of Application mailed on May 28, 1999, which set forth a two (2) month shortened statutory period for reply. Petitioner obtained a four (4) month extension of time to reply. Accordingly, this application became abandoned on November 29, 1999. A Notice of Abandonment was mailed on June 22, 2000.

A review of the file revealed that on May 28, 1999, the Office mailed a Notice to File Missing Parts of Application to petitioner, which set forth a two (2) month shortened statutory period to submit the required payment of the basic filing fee, a properly signed oath or declaration in compliance with 37 CFR 1.63, and a surcharge for their late filing.

On December 2, 1999 (certificate of mailing Monday, November 29, 1999), petitioner filed a declaration and power of attorney, a \$380.00 filing fee, a \$65.00 surcharge, a request for a four (4) month extension of time, a petition under 37 CFR 1.47(a), and a declaration of facts of Timothy H. Gens, attorney of record. However, petitioner failed to pay the requisite petition fee of \$130.00 as set forth in 37 CFR 1.17(i).

The rules and statutory provisions governing the operations of the Office require payment of a fee upon filing a petition under 37 CFR 1.47(a). In this instance, the fee required was \$130.00. See 37 CFR 1.17(i). The petition

under 37 CFR 1.47(a) was not accompanied by payment of the required fee. Therefore, the petition under 37 CFR 1.47(a) was not considered on its merits. Petitioner was notified in a letter dated June 22, 2000, that petitioner must file a petition to revive under 37 CFR 1.137 and pay the proper petition fees within one (1) month of the date of the decision. Petitioner was informed that the petition under 37 CFR 1.47(a) would remain in the file until such time as petitioner had filed a grantable petition to revive.

Although petitioner filed a petition under 37 CFR 1.47(a) on December 2, 1999 (certificate of mailing Monday, November 29, 1999), petitioner was not relieved of the requirement to submit a timely and proper reply to the Notice to File Missing Parts of Application of May 28, 1999. Section 1.135(b) of the Code of Federal Regulations states, in relevant part: "Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require." Because petitioner failed to submit a timely and proper reply to the Notice on or before Monday, November 29, 1999, within the meaning of 37 CFR 1.135(b), this application was properly held abandoned on November 29, 1999.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee as set forth in § 1.17(l);
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

The present petition to revive lacks item (3) above.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most

important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner states: " The petitioner was unable to obtain the signature of co-inventor Victor Manneh thus making the filing of a proper reply unavoidable.... Because of his refusal to sign the Declaration, filing a proper Response to the Notice to File Missing Parts of Application was unavoidable." *Petition dated July 27, 2000, p. 1.*

The Office reminds petitioner that the application became abandoned for petitioner's failure to submit the required fee of \$130.00 for the petition under 37 CFR 1.47(a). The fact that petitioner was unable to obtain the signature of the co-inventor is irrelevant as to why petitioner failed to pay the \$130.00 petition fee in order to avoid abandonment.

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). Accordingly, the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 USC 151 and 37 CFR 1.137(a). The petition under 37 CFR 1.47(a) will remain in the file until such time as petitioner has filed a grantable petition to revive.

Petitioner may wish to consider filing a renewed petition under amended 37 CFR 1.137(b). 37 CFR 1.137(b) now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in § 1.17(m), \$605.00 for a small entity;

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to 37 CFR 1.137(c).

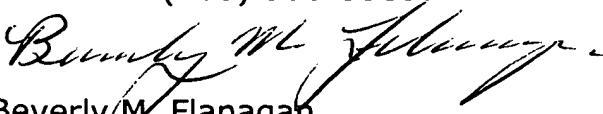
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